UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,603	02/06/2001	Robert G. Roodman	3576-010027	3170

7590 09/18/2002

Kent E. Baldauf
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

EXAMINER
CINTINS, IVARS C

ART UNIT	PAPER NUMBER
1724	4

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC 4

Office Action Summary	Application No. 09/777,603	Applicant(s) Roodman et al.
	Examiner Ivars Cintins	Art Unit 1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above, claim(s) 17-28 is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-16 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 & 3
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-16, drawn to an activated carbon composition, and process for its preparation, classified in class 502, subclass 418.

II. Claims 17-28, drawn to a method for purifying an aqueous solution, classified in class 210, subclass 694.

The inventions are distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group I could be used in another process, different from that of Group II. For example, this material could be used to purify fluids (e.g. air, oil, etc.) other than aqueous solutions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, and because the searches for the individual Groups are not

coextensive, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Richard Byrne on September 16, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by Applicant in replying to this Office action. Also, Mr. Byrne stated that although claims 25-28 recite composition in their preamble, these claims are intended to be method claims. Accordingly, claims 17-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 8, 9 and 12-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The terms "such as" (claim 6, line 3), "useful as" (claim 9, line 3) and "preferred amount" (claims 12 and 14, line 3) are vague, and indefinite as to the limitations intended. Also, the recitation of ammonium, sodium or potassium

salts in the Markush group of claim 8 is indefinite, since these salts do not appear to be hydroxy carboxylic acids, as recited in line 2 of this claim. Claims 13 and 15 depend from an indefinite claim, and are therefore themselves indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-12 and 14 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Kashiba (U.S. Patent No. 6,114,162). See col. 2, lines 36-40 and 53.

Claims 1, 7-12 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Roy (U.S. Patent No. 5,348,755). See col. 11, lines 34-56.

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Helmig (U.S. Patent No. 5,437,797). See col. 2, lines 23-24.

Claims 1 and 7-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kinkead et al. (U.S. Patent No. 5,626,820). See col. 9, lines 26-27.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-5, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kashiba. Kashiba discloses the claimed invention with the exception of the amount of carboxylic acid and water present in the composition (claims 3-5 and 13), the duration of contact between the carboxylic acid and activated carbon (claim 15), and the drying time and temperature employed (claim 16). However, the exact amount of carboxylic acid and water present in the reference composition, the exact amount of time that the carboxylic acid and activated carbon are contacted with one another, and the exact drying time and temperature employed are not seen to materially affect the overall results of the reference system, or to produce any new and unexpected results; and are therefore deemed to be obvious matters of

choice, which are insufficient to patentably distinguish the claims.

Claims 3, 6, 13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy. Roy discloses the claimed invention with the exception of the amount of carboxylic acid present in the composition (claims 3 and 13), the source of the activated carbon (claim 6), the duration of contact between the carboxylic acid and activated carbon (claim 15), and the drying time and temperature employed (claim 16). However, the exact amount of carboxylic acid present in the reference composition, the exact source of the activated carbon in this reference, the exact amount of time that the carboxylic acid and activated carbon are contacted with one another, and the exact drying time and temperature employed are not seen to materially affect the overall results of the reference system, or to produce any new and unexpected results; and are therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

The fax phone numbers for this art unit are: (703) 872-9311 for "Official" faxes after Final Rejection; (703) 872-9310 for all other "Official" faxes; and (703) 872-9492 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Ivars Cintins

Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
September 17, 2002